

Applicants : Josette Masle et al.
Serial No. : 10/519,135
Filed : August 15, 2005
Page 2 of 6

REMARKS

The June 14, 2006 Office Action imposes a restriction requirement under 35 U.S.C. §§121 and 372. The Examiner alleged that the subject application contains the following inventions or alleged groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. The Examiner alleged that, in accordance with 37 C.F.R. §1.499, applicants are required, in response to the June 14, 2006 Office Action, to elect a single invention to which the claims must be restricted among the following seven allegedly independent and distinct inventions:

- I. Claim(s) 1 to 6, 9 and 10, drawn to a method of selecting a plant having enhanced transpiration efficiency, comprising detecting a genetic marker for transpiration efficiency which marker comprises a nucleotide sequence genetically linked to an ERECTA locus in the genome of the plant and selecting a plant that comprises or expresses the genetic marker, or wherein the transpiration efficiency phenotype of the plant is linked to the expression of marker in the plant;
- II. Claim(s) 1 to 5 and 7 to 10, drawn to a method of selecting a plant having enhanced transpiration efficiency, comprising detecting a genetic marker for transpiration efficiency which marker comprises a nucleotide sequence genetically linked to an ERECTA locus in the genome of the plant and selecting a plant that comprises or expresses the genetic marker, or wherein the transpiration efficiency phenotype of the plant is linked to a structural polymorphism in DNA;

Applicants : Josette Masle et al.
Serial No. : 10/519,135
Filed : August 15, 2005
Page 3 of 6

- III. Claim 11, drawn to a method of selecting a plant having enhanced transpiration efficiency, comprising screening mutant or near-isogenic or recombinant inbred lines of plants to segregate alleles at an ERECTA locus; identifying a polymorphic marker linked to said ERECTA locus; and selecting a plant that comprises or expresses the marker;
- IV. Claim(s) 12 to 19, drawn to a method of enhancing the transpiration efficiency of a plant comprising introducing an isolated ERECTA gene or an allelic variant thereof or the protein-encoding region thereof to a plant and selecting a plant having different transpiration efficiency compared to a near-isogenic plant that does not comprise the introduced ERECTA gene or allelic variant or protein encoding region;
- V. Claim(s) 12 to 17, 20 and 21 drawn to a method of reducing the transpiration efficiency of a plant comprising introducing an isolated ERECTA gene or an allelic variant thereof or the protein-encoding region thereof to a plant and selecting a plant having different transpiration efficiency compared to a near-isogenic plant that does not comprise the introduced ERECTA gene or allelic variant or protein encoding region;
- VI. Claim(s) 22 and 23, drawn to a plant having modified transpiration efficiency compared to a near-isogenic plant; and

Applicants : Josette Masle et al.
Serial No. : 10/519,135
Filed : August 15, 2005
Page 4 of 6

VII. Claim(s) 24 and 25, drawn to an isolated ERECTA gene capable of determining or modulating the transpiration efficiency of a plant.

The Examiner alleged that the inventions listed as Groups I-VII do not relate to a single inventive concept under PCT Rule 13.1, because, the Examiner alleged, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following alleged reasons.

The Examiner alleged that the technical feature linking Groups I-VII appeared to the Examiner to be ERECTA gene capable of determining or modulating transpiration efficiency. However, the Examiner alleged, Hainey et al. (NCBI, GenBank, Sequence Accession No. AY106598, published May 25, 2002) teach a polynucleotide sequence encoding for a polypeptide which has 100% sequence identity to instant 44. The Examiner alleged that the properties of determining or modulating transpiration efficiency is inherent to the polynucleotide encoding said polypeptide taught in the reference.

Therefore, the Examiner alleged, the technical feature linking Groups I-VII does not constitute a special technical feature as defined by PCT Rule 13.2 as it does not define a contribution over the prior art. Accordingly, the Examiner alleged, Groups I to VII are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

The Examiner stated that different nucleotide sequences and amino acid sequences are structurally distinct chemical compounds and are unrelated to one another. The Examiner alleged that these sequences are thus deemed to normally constitute different inventive concepts.

Applicants : Josette Masle et al.
Serial No. : 10/519,135
Filed : August 15, 2005
Page 5 of 6

For these alleged reasons, the Examiner alleged that Applicants are also required to elect one nucleotide sequence and its encoded polypeptide. The Examiner alleged that, in the instant case, for Groups I, II, IV and V, one nucleotide sequence and its encoded protein must be elected from SEQ ID NOs: 1-45 and for Group VII one of nucleotide sequence and its encoded protein must be elected from SEQ ID NOs: 11-45.

Accordingly, the Examiner alleged, Groups I-VII are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

In response, applicants elect Group IV and SEQ ID NOs: 1-2, with traverse, for initial examination. Applicants, however, respectfully request that the Examiner reconsider and withdraw the restriction requirement for the reasons that follow.

Initially, applicants request that the Examiner reconsider and withdraw the restriction requirement as to Group V, claims 22 and 23 in so far as these claims depend from elected claims 12 to 19 of Group IV since claims 22 and 23 are related to claims 12 to 19 as product and process for obtaining such product.

Further, under M.P.E.P. §803, the Examiner must examine the application on the merits if examination can be made without serious burden, even if the application would include claims to distinct inventions. That is, there are two criteria for a proper requirement for restriction: (1) the invention must be independent or distinct, and (2) there must be a serious burden on the Examiner if restriction were not required.

Applicants respectfully submit that there would not be a serious burden on the Examiner if restriction were not required, because a search of the prior art relevant to alleged Group IV, i.e.

Applicants : Josette Masle et al.
Serial No. : 10/519,135
Filed : August 15, 2005
Page 6 of 6

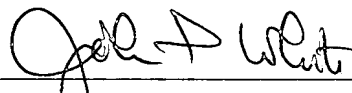
claims 12 to 19, would not necessarily pose a serious burden once the prior art once the prior art for alleged Groups I to III and V to VII has been identified.

Therefore, there is no burden on the Examiner to examine Groups I-VII together in the subject application. Hence, applicants maintain that the Examiner must examine claims 1 to 25 on the merits.


In view of the foregoing, applicants maintain that restriction is not proper under 35 U.S.C. §§121 and 372, and respectfully request that the Examiner reconsider and withdraw the requirement for restriction under 35 U.S.C. §121.

No fee other than the enclosed fee of \$120.00 is deemed necessary in connection with the filing of this Communication. However, if any fee is required authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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